Supreme Court of the United States

OCTOBER TERM, 1941, No.

WHITSON PHOTOPHONE CORPORATION and DELMAR A. WHITSON,
Petitioners,

vs.

CONWAY P. COE, Commissioner of Patents; AMERICAN TRI-ERGON CORPORATION, TRI-ERGON HOLDING A. G., RADTKE PATENTS CORPORATION and ALBERT A. RADTKE,
Respondents.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

I. Opinion of the Court Below

The opinion of the District Court is reported in 30 Fed. Supp. 83. The opinion of the Court of Appeals of the District of Columbia has not as yet been officially reported but is contained in III R. 2056.

II. Grounds of Jurisdiction and Statement of Case

These matters are believed to be sufficiently set forth in the foregoing petition.

III. Assignment of Errors

Petitioners urge that the United States Court of Appeals of the District of Columbia erred:

1. In finding the subject matter involved here to lack invention and thus to be unpatentable upon a consideration of matters and issues outside of the pleadings and proofs and as to which petitioners have had no fair opportunity to be heard.

2. In finding lack of invention in the technical subject here involved upon a consideration of scientific treatises (some of which are not in evidence and some of which were published after petitioners' date of conception and disclosure) without the aid and benefit of expert testimony, opinion and consideration of such treatises, and without findings of the trial court or Commissioner of Patents in support thereof.

3. In attempting to protect the public interest where such interest is adequately represented by the Commissioner of Patents and where such protection is moot by virtue of the grant of the monopoly of an issued patent.

4. In treating statements made by the parties during the course of the prior proceedings with respect to amplifiers and their circuits as admissions of lack of invention in petitioners' immediate photoelectric cell circuit.

5. In failing to construe and interpret the prior art as of petitioners' date of conception and disclosure and in construing such art as of a much later date.

6. In adopting rulings and findings of the Commissioner of Patents which had been reversed by later final decisions of such Commissioner and by decisions of the District Court.

7. In finding that experiments and writings by others which never achieved success to be evidence of lack of invention.

8. In failing to find that petitioners were the first and original inventors of the subject matter involved herein and in failing to direct the District Court to enter a decree

in favor of petitioners authorizing the Commissioner of Patents to grant a patent to petitioners and in failing to reverse the decree finding that petitioners lacked priority.

IV. Argument

POINT 1

The issue of lack of invention was not before the court and petitoners had no fair hearing thereon

As is quite apparent from a perusal of the record herein, the scientific matters therein discussed are of quite a technical nature and the testimony of the experts is very lengthy. Supplementing such testimony numerous scientific treatises and publications, as well as many other issued patents, have been introduced into evidence. Despite all this the Court of Appeals departed from the record to decide the entire case upon an issue never raised in this action—an issue finally decided some ten years ago by the Supreme Court of the District of Columbia in the so-called Adkins' decision (Supra, p. 4; II R. 1646-50)—decided contrary to the majority decision below.

As is pointed out (supra, p. 4), upon the entry of the Justice Adkins' decision, the Commissioner of Patents declared the interference and directed proofs as to priority. From this date, January 7, 1932, to the present time, the issue of lack of invention has never arisen in this case—has never been presented in the pleadings of the parties, in the testimony of witnesses, in the documents introduced into evidence, or in the briefs of any of the parties hereto. No testimony was introduced on this point, therefore no cross examination thereon was had. No testimony was introduced, therefore no notice was conveyed to petitioners to go to their proofs on this point.

The issue of lack of invention has been presented only prior to the Adkins' decision, in the inter-office proceed-

ings of the Patent Office and in the District Court before Justice Adkins, and finally and completely decided by him, and in the brief of *amicus curiae* before the Court of Appeals.

Petitioners have been denied their day in Court and, therefore, come within the rule of Helis v. Ward, 308 U. S. 365 at 370:

> "For review by this Court was sought and granted on the ground that the Circuit Court of Appeals had decided the merits on facts not contained in the record and on a theory which had never been tried by the litigants."

As pointed out in Walker on Patents, Deller's Ed., Vol. 3, p. 2025, ". . . It is generally necessary for a defendant to introduce expert testimony on that point (invention) for a question of invention is a question of fact."

The question of invention being one of fact, we have in the present case a situation in which the Court of Appeals has made a finding without any evidence on the fact being before it. The issue is one which is open to much dispute and should not be the subject of judicial notice and, to quote the dissenting opinion below, the appellate court should not

> "reach an answer to such a question upon the basis of its own examination of data not in the record, . . . without first affording opportunity to the parties to be heard in respect to it and an opportunity to supply additional relevant data." (III R. 2080).

We submit that your petitioners have been denied their day in court and should be accorded an opportunity to present their proofs respecting lack of invention.

POINT 2

The Court of Appeals was not justified in attempting to protect the public interest

Adopting the rule and decision in Hill v. Wooster, 132 U. S. 693, the Court of Appeals stated:

> "In our capacity as guardian of the public interest, . . . we must consider the question (invention)." (III R. 2059).

We submit that the court misconstrued and misapplied the decision of that case. In Hill v. Wooster, supra, an interference action had been declared and, after decision by the Commissioner of Patents, an action was commenced under R. S. 4915. The Commissioner was not a party to that action and the question of invention was not presented by the two litigants. In that case there was no prior finding of invention by the District Court. It was held in that case that, in the interests of the public, the court should consider the question of invention. It is apparent that Hill v. Wooster and the present action are dealing with two different horses. Here we have a decision (prior to the declaration of interference) by the District Court that the subject matter is invention and is patentable. We have a finding of patentability by the Commissioner of Patents in the interference action based upon such decision. We have a finding by Justice Goldsborough in the lower court of "neither the error or the evidence" (III R. 2058) that there was error in the Adkins' decision or additional evidence which would have produced a different result in the Adkins' decision. And in addition the Commissioner of Patents *is* a party to the present action.

The Commissioner of Patents is the officer charged with the protection of the public interests in the matter of granting the exclusive monopoly conferred by Letters Patent.

In his pleadings in this action he alleged the correctness of the final decisions by the Commissioner. He did not seek to overcome the monopoly granted by the patent issued, by alleging a lack of invention. That point had already been determined by Justice Adkins and that determination has long been final. The Commissioner could have appealed from Justice Adkins' decree, but he did not. He, representing the People of the United States, accepted that decision. In seeking to protect the public interest the Court of Appeals has stepped from its position as a reviewing court into the position of the Commissioner of Patents as the guardian of the public interests in patent monopolies. It has usurped the function of an administrative officer which it has no power to do. But, even assuming the power, if it has usurped that function, and therefore represents the People, then it is subject to whatever limitations the People are subject. The People, being bound by the actions of the Commissioner of Patents, the representatives of the People are likewise bound—the Court, usurping that power, representing the People, is bound by the People's acquiescense in that decision.

But even more, the question of patentability, so far as the present litigation is concerned, has become moot—the monopoly has been granted by the patent issued to Radtke. The majority decision protects, not the People of the United States, not the public interest, but the party Radtke and his interest. The majority decision bars Whitson and Vogt from asserting their rights to a patent, and leaves Radtke with his patent. With this patent Radtke may go to another district and enforce rights protected by the patent. (McNeeley v. Williams, 96 Fed. 978.) The question of patentability may be raised in another district and a different conclusion reached. (Lowell v. Triplett, 77 Fed. (2) 556; affirmed in 297 U. S. 638; rehearing denied 298 U. S. 691.) But, to no other district may Whitson or Vogt go to secure

patents—Radtke has a patent—Radtke, the one party to this action who, by his own testimony, is not entitled to a patent because of wilful suppression and concealment (II R. 1057). To no other district may Whitson or Vogt go to enforce their rights for, without a patent, they have no rights.

We submit that the Court of Appeals did not protect the interests of the public in rendering its decision.

POINT 3

The Court of Appeals should have construed and interpreted the prior art as of January 24, 1915, rather than March 3, 1919.

The Court of Appeals stated in its decision (III R. 2058):

> "However, the first and most important question which was presented for decision to the District Court, which was presented on this appeal by *amicus curiae*, and which we must now decide, is whether the four claims in issue do define an invention, patentable as of March 3, 1919."

This date of March 3, 1919, as stated heretofore, was the date upon which the party Vogt filed his application in Germany for a patent on the subject matter involved here. It has always been contended by the party Vogt that, under the Convention rule, he is entitled to rely upon this date as his filing date, even though his United States filing was later in date. The Court of Appeals arbitrarily adopted this date as the earliest date to which any of the parties was entitled, without making any finding upon the conflicting issues and contentions respecting said early dates.

It is the contention and allegation of Whitson that he conceived his invention prior to January 24, 1915, and that

on said date he disclosed his ideas and conceptions to others. It is not the date of filing an application for a patent which is controlling, but the date of conception.

> "While the first and original inventor, generally speaking, is *prima facie* the one who first reduces an invention to practice, i. e., reduces his invention to a fixed, positive and practical form, the one who first conceives an invention and proceeds to perfect it and adapt it with reasonable diligence, *may date back his invention to the date of conception* and succeed as to priority over a second inventor who has, in fact, first perfected and actually reduced his invention to practice in a positive form." (Emphasis ours.) Walker on Patents (Deller's Ed. 1937, p. 378).
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> ". . . Under our patent system, he who first arrives at a complete conception of the inventive thought is entitled to recognition and reward. . . . " Laas v. Scott, 161 Fed. 122.

If, then, he who first arrives at a "complete conception of the inventive thought" is entitled to a patent, as a necessary corollary to that rule, that conception must be of an invention.

> "In determining whether patentable invention is involved, it is proper to take into consideration the condition of the trade or art to which the patent is applied. Other factors to be considered are those which show the character, condition and progress of the art to which the invention relates; the nature of the want supplied; and the extent to which previous inventions had satisfied the want. So also, proof of prior unsuccessful efforts of others to accomplish the results obtained, may resolve a doubt in favor of invention." (Citing cases.) Walker on Patents (Deller's Ed. 1937, p. 119.) And again on page 120:
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> "It may also be shown that the invention in question is more efficient than the method or device pre-

viously used for the same or analogous purposes, or more economical, or has other advantages over known methods or devices."

It has always been the contention of Whitson that he antedated most of the prior art references used throughout this extensive litigation; that at the time of his conception no one taught, in patents, publications, or otherwise, the use of the photo-electric cell for the reproduction of sound. It is an accepted fact that photoelectric cells had been used for quite some time prior to 1915 for photometric purposes (measuring the quantity of light) by astronomers and by others. The properties of photoelectric cells had long been known. It was known that the "lag" or "fatigue" of selenium cells was not present in photoelectric cells. But, no references, whether put in evidence by the parties hereto, or not in evidence but cited by the Court of Appeals, shows or teaches the use of photoelectric cells for reproduction of sound.

It has long been Whitson's contention that he invented, not a circuit, but a means of reproducing sound. Radtke makes great "to do" over his "resistance"—Vogt uses undamped high frequency—but Whitson uses a simple circuit (Radtke's circuit without the resistance) and it works, as evidenced by Tasker's testimony (Radtke's expert) during the trial below (II R. 1195). Whitson contends, not that he invented a circuit, not that he has to use a particular circuit, but merely that he invented a method of reproducing sound by means of a photoelectric cell; that he conceived this invention as of January 24, 1915, as evidenced by Whitson Interference Exhibit No. 10. Therefore, whether Whitson did or did not invent anything must be decided

from a study of the art as it existed at the time he claims invention—not as of a later date.

No reason has been assigned by the Court of Appeals for its failure to consider invention as of Whitson's date of Conception and disclosure. If the Court, as it did, considered authorities arising between January 24, 1915, and March 3, 1919, and concluded that they anticipated the invention as of March 3, 1919, it does not follow that the same invention as of 1915 would fall in the same category.

We submit that Whitson has again been denied his day in Court by a failure to construe the prior art as of the date of Whitson's disclosure, January 24, 1915.

POINT 4

The Court of Appeals incorrectly construed the prior art on its merits.

The majority decision of the Court of Appeals proceeds at great length to arrive at the conclusion that the use of a photoelectric cell to reproduce sound was an obvious substitution for the selenium cell which any mechanic in the art could have made. However, a much simpler device was held to be invention in The Barbed Wire Patent Case, 143 U. S. 275, where this Court said:

> "It may be strange that, considering the important results obtained by Kelly in his patent, it did not occur to him to *substitute* a coiled wire in place of the diamond shape prong, but evidently it did not; *and to the man to whom it did ought not to be denied the quality of inventor.*" (Emphasis ours.)

In Loom Co. v. Higgins, 105 U. S. 580, at 591 this Court stated some very pertinent language:

> "It may have been under their very eyes, they may almost be said to have stumbled over it; but they cer-

tainly failed to see it, to estimate its value, and to bring it into notice. . . . *Now that it has succeeded, it may seem very plain to any one that he could have done it as well.* This is often the case with inventions of the greatest merit." (Emphasis ours.)

And in George Frost Co. v. Cohn, 112 Fed. 1009, it was held that the substitution of a rubber button for a metallic button on a garter was invention, even though the properties of rubber had long been known and used for just such things.

The only prior art reference cited as of a date prior to Whitson's date of conception and disclosure, January 24, 1915, is the article by Bergwitz in Physikalische Zeitschrift (1907) 378, Radtke Suit Exhibit "FF," (III R. 1945) in which the author states:

> "Undoubtedly on basis of the experiments related here, it will be possible to transmit telephone signals at some distance in the same way as with the selenium cell." (English translation III R. 1951.)

Immediately we reread the article to ascertain how he proposes to do this. Not only do we find that the author does not tell us how, but we note the language that he proposes to transmit signals, not reproduce sound. This cannot be said to be anticipation.

> "Prophetical suggestions and surmises in prior patents or publications, of what results can be achieved in a particular art, are not enough to negative the novelty of any patent on an invention which can accomplish that result."
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> Westinghouse Air-Brake Co. v. Great Northern Ry., 88 Fed. 258, C. C. A. 2 (1898);
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> Asbestos Shingle, etc., Co. v. H. W. Johns-Manville Co., 184 Fed. 620, C. C., S. D. N. Y. (1910).
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> "But when such a patent merely *prophesies* what can be done without setting forth that it has been done,

> or makes claims for things not fairly disclosed in the specifications, the foreign patent does not anticipate." Becket v. Coe., 98 Fed. (2) 332, App. D. C. (1938).

Under these authorities, should it be said that Bergwitz conceived the subject matter here in issue? Can it be said that Bergwitz' article amounted to more than wishful thinking? Yet the Court of Appeals has cited this article as anticipation—cited the article to show that those skilled in the art could produce the subject matter here involved. Yet, to digress beyond the record on our own part, in the early 1920s patents were still being sought and granted for reproduction of sound using *selenium* cells, even though it was well known that these cells had a lag and fatigue which rendered them unfit for sound frequencies. Yet men in the art were still trying to make them work. Can it be then said that men skilled in the art could take the prior teachings and use photoelectric cells to reproduce sound from acoustically modulated light?

The Court of Appeals has proceeded, in the majority decision, upon a false premise as evidenced by its language at III R. 2077:

> "We are satisfied that, individually and collectively, they (the parties hereto) have successfully challenged every contention and disproved every claim."

The Court has misconstrued the evidence. Testimony on the part of Whitson has been introduced to show that at the time of filing his application (August 20, 1920) men skilled in the art knew how to connect an amplifier or Audion tube in a circuit with a photoelectric cell in order to amplify the feeble currents of such cell. The introduction of this testimony was rendered necessary by a smoke screen created by our opponents, namely, that Whitson's application did not disclose an operable invention because it did not show the circuit connections to the various elements of

the Audion tube and also because his battery designations did not show potentials or polarities. Whitson also introduced testimony to show that men skilled in the art would know how to connect batteries and to determine the correct potential by "cut and try" methods. To show how foolish some of these adverse contentions were, Whitson Interference Exhibit No. 338, the United States Patent Office Chart for Draftsmen, sheet 2, symbol No. 62 does not require that any polarity be shown. From the fact that Whitson contends that photoelectric cells were so well known that men skilled in the art knew how to connect them, and from the testimony to that effect, the Court concluded that they were so well known that it was not invention to use them for sound reproduction.

We submit that the prior art has been improperly construed and applied by the Court of Appeals.

POINT 5

The subject matter is of general importance justifying review by this Court

In Altoona Publix Theatres Inc. v. American Tri-Ergon, 294 U. S. 477, the subject matter there involved concerned the same field as that involved here and the latter is of equal importance with that there involved.

CONCLUSION

The United States Court of Appeals for the District of Columbia has rendered a decision which is novel, erroneous, of public importance and seriously prejudicial to your petitioners.

WHEREFORE, petitioners pray that their petition for writ of certiorari be granted and the cause be reviewed

and the petitioners granted such relief as may be found just and proper.

Respectfully submitted,

JOSEPH A. SHAY,
KIMBALL FLETCHER, JR.,
Counsel for Petitioners.

Dated, Los Angeles, October 29, 1941.